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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,205	06/20/2005	Tsumeo Yamada	21604-00023-US1	3475

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EXAMINER

VOGELBACKER, MARK T

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/540,205	Applicant(s) YAMADA ET AL.	
	Examiner Mark T. Vogelbacker	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/01/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed June 20, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specifically, Citation No. "BA", "BB", "CA" and "CB" have not been considered since a copy of each has not been provided.

Specification

2. The disclosure is objected to because of the following informalities:
On page 10, line 10, delete "and" following "second abutment".
Appropriate correction is required.

Claim Objections

3. Claims 2 and 3 are objected to because of the following informalities:
Regarding claim 2, page 11, line 9, the word "rotay" appears to be incorrectly spelled.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 3 of page 9, the phrase "or the like" renders claims 1-3 indefinite because claim 1 includes elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d). In line 9 of page 9, the phrase "may be" is confusing. Is the first member capable of rotating relative the second member only under certain circumstances? In lines 13-14 of page 9, the phrase "the excessive rotation preventing mechanism fits around an annular rotary member" seems contradictory to the rest of Applicant's Specification. Isn't the rotary member one of a number of parts that make up the excessive rotation prevention mechanism? If this is the case, this phrase in lines 13-14 of page 9 conveys that the rotary member is a separate entity from the excessive rotation preventing mechanism. In line 23 of page 9, the phrase "but allows" is confusing. What structure is being referred to in this recitation? In line 3 of page 10, the phrase "is provided" is confusing. What structure is being referred to in this recitation?

Regarding claim 2, line 2 of page 10, the phrase "fits around" seems contradictory to the rest of Applicant's Specification. Aren't the "excessive rotation preventing mechanism" and the "rotary member" part of the same structure? If this is the case, how can one "fit around" the other? In lines 13-14 of page 10, the phrase "by said first abutment retainer mechanism" is confusing. Is this recitation necessary? What limitation does it represent? In line 7 of page 11,

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the phrase “and for being abutted against” is not clear. Does this recitation refer to the first abutment portion (12) or the third abutment portion (15)? In line 8 of page 11, the phrase “out of the” does not make sense. What does this recitation mean?

Regarding claim 4, line 3 of page 12, the phrase "or the like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d). In line 9 of page 12, the phrase “may be” is confusing. Is the first member capable of rotating relative the second member only under certain circumstances? In lines 12-13 of page 9, the phrase “the excessive rotation preventing mechanism fits around an annular rotary member” seems contradictory to the rest of Applicant’s Specification. Isn’t the rotary member one of a number of parts that make up the excessive rotation prevention mechanism? If this is the case, this phrase in lines 12-13 of page 12 conveys that the rotary member is a separate entity from the excessive rotation preventing mechanism. In line 19 of page 12, the phrase “may be” is confusing. Are the shaft portion and the rotary member capable of rotating in any direction only under certain circumstances? Lines 20-21 of page 12 recite the limitation "said first abutment retainer mechanism". There is insufficient antecedent basis for this limitation in the claim. In lines 22-23 of page 12, the phrase “by said first abutment retainer mechanism” is confusing. Is this recitation necessary? What limitation does it represent? In line 2 of page 13, the phrase “and for being abutted against” is not clear. Does this recitation refer to the first abutment portion (12) or the third abutment portion (15)?

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura, US-5,913,351 in view of Kim, US-6,618,903.

Miura discloses the invention as claimed, including a hinge device (Figure 1) to rotate a first member of an electronic instrument relative to a second member (col 1, lns 6-11). The hinge device has first coupling member (3) having a shaft portion (5), a second coupling member (2) having a bearing hole (2a) and an annular rotary member (9). An abutment portion (5a) on a circumferential surface of the shaft portion (5) contacts a projection (9b) provided on the rotary member (9). If the first coupling member (3) or second coupling member (2) is rotated in any direction, the rotary member (9) is cooperatively rotated with the shaft portion (5). Further, a projecting portion (2c) projects from a surface of the second coupling member (2). However, Miura does not mention that projection is abutted and retained against the projecting portion. Kim teaches the invention as claimed, including a hinge device (10) to rotate a first member (120) of an electronic instrument relative to a second member (110). Kim teaches a first coupling member (20) having a shaft portion (231), a second coupling member (40) having a bearing hole (44) and an annular rotary member (60) with a projection (66). A projecting portion (46) projects from a surface of the second coupling member (40). The projection (66) is abutted and retained against the projecting portion (col 5, lns 7-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the hinge device of

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Miura to include a second abutment retainer mechanism, as taught by Kim, that allows the first member to rotate smoothly relative to the second member (col 1, lns 17-20).

Examiner notes that it has been held that the recitation that an element is "adapted to" perform a function, as used by Applicant in claim 1, line 4 of page 10, is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Allowable Subject Matter

8. Claims 2 and 3 are objected to as being dependent upon a rejected base claim, but would be given favorable consideration if rewritten in independent form including all of the limitations of the base claim and any intervening claims and rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office Action.

9. Claim 4 would be given favorable consideration if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office Action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Vogelbacker whose telephone number is (571) 272-1648. The examiner can normally be reached on 8:00 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MTV

Mark Vogelbacker
Assistant Examiner
Art Unit 3677


ROBERT J. SANDY
PRIMARY EXAMINER